

**REMARKS**

The Examiner is thanked for the careful examination of the application.

**Claim Amendments**

Claims 1, 2, 44 and 45 have been amended to essentially recite that identification of the location of the wetness indicator (the plurality of wetness indicators) on or adjacent to the strip part (strip) is facilitated by the strip part (strip) that has a color and wherein that color is different than the color of the remaining part of the backsheet. And, that the strip part (strip) has a width of between 1 and 6 cm.

Support for this amendment may be found throughout the specification and at least at the Figures and at paragraph [0016] of the PG Pub. Entry and consideration of the amendments is respectfully requested.

**§ 102(e) - Cammarota**

Claims 1, 2, 5-11 and 19-25 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Cammarota (USPN 6,307,119). Applicant respectfully traverses this rejection.

**I - Patent Office Assertions**

The Office has asserted that "it is noted that the indicia of the claimed articles is considered printed matter, and where no new and unobvious functional relationship between the printed matter and the article exists, the printed matter will not distinguish the invention from the prior art in terms of patentability (see MPEP 2112.01(III)). Therefore, the indicia providing an indication of the size or absorption capacity does not distinguish over the article of Cammarota."

**II - Applicant Assertions**

First, applicant asserts that the Office has simply made an unsupported conclusion. And, accordingly, a *prima facie* case of anticipation has not been established. The Office has concluded that "no new and unobvious functional relationship between the printed matter and the article exists," but has not made an explanation of how this conclusion was reached. The Office has not met the burden of establishing the absence of a novel, nonobvious functional relationship.

Second, applicant asserts that the Office cannot establish the absence of a novel, nonobvious functional relationship between the printed matter and the article at issue.

### **III - "Printed Matter" History and Case Law**

As a starting point, the original purpose of denying patentability as a result of distinguishing "printed matter" was because printed matter was essentially copyrightable subject matter, not patentable subject matter. See, e.g., *Guthrie v. Curlett*, 10 F.2d 725 (2d Cir. 1926). The early cases which considered printed matter concerned various kinds of printed business forms. The courts, in those cases, found no invention in the arrangement of the printed matter. See, e.g., *United States Credit System Co. v. American Credit Indemnity Co.*, 59 F. 139 (2d Cir. 1893).

However, the courts quickly found that certain uses of printed matter could support patentability. See, e.g., *Flood v. Coe*, 31 F.Supp. 348 (D. D.C. 1940) ("The invention here is more than an arrangement of printed matter on a piece of paper. There is a definite and decided relationship between the physical structure and the printed matter. The one depends upon the other.").

***Importantly, the CCPA has recognized that indicia can give patentable weight.*** *In re Miller*, 418 F.2d 1392 (CCPA 1969), concerned a measuring device designed to enable cooks to prepare fractional recipes without having to compute and measure out such quantities as 1/3 of 2/3 cup. Miller's invention consisted of proportionally-scaled measuring cups and spoons. For example, a measuring cup may be designated "one-half recipe" and then be calibrated in the normal fashion of 1/4 cup, 1/3 cup, 1 cup, etc. A cook could then follow the recipe numbers literally and yet prepare a one-half recipe. The Patent Office rejected the claims as unpatentable under the printed matter rule because an element of each claim was a legend on the receptacles and there was no novel relation between the printed legend (such as "one-half recipe") and the claimed structure. The CCPA reversed, stating:

'We do not see that structural relationship--whatever that means--is required to obtain the practical, problem-solving results of appellant's invention ... . ... [P]rinted matter, in an article of manufacture claim, *can* be given patentable weight. ... [N]o attempt is here being made to patent printed matter as such. The fact that printed matter *by itself* is not patentable subject matter, because non-statutory, is no reason for ignoring it when the claim is directed to a combination. Here there is a new and unobvious functional relationship between a measuring *receptacle*, volumetric ***indicia*** thereon indicating volume in a certain ratio to actual volume, and a *legend* indicating the ratio. ... **The solicitor seems to urge that we *ignore* the claim limitations to the legends because they are printed and because printed matter is not**

**patentable subject matter by itself. For reasons indicated above we reject that argument.**

*In re Miller*, 418 F. 2d at 1392 (emphasis added).

The Federal Circuit has followed the precedent established by the CCPA. See *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983) and *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). In *In re Lowry* the Federal Circuit reversed a PTO "printed matter" rejection and asserted that *Gulack cautioned against "liberal use of 'printed matter rejections' under section 103."* *In re Lowry*, 32 F.3d at 1582-83.

Further, in *In re Lowry* the Federal Circuit asserts that "As part of its burden to establish a *prima facie* case of obviousness, ... **the burden of establishing the absence of a novel, nonobvious functional relationship [between the printed matter and the article exists] rests with the PTO.**" *In re Lowry*, 32 F.3d at 1584 (emphasis added).

#### **IV - State of the Law**

Accordingly, the case law is quite clear that the PTO has the burden of establishing the absence of a novel, nonobvious functional relationship between the printed matter and the article exists.

And, the PTO has been cautioned against liberal use of "printed matter rejections" under section 103.

And, indicia (as printed matter) have been recognized as capable of giving patentable weight.

#### **V - Application of the Law**

The Office has made a conclusory statement that no new and unobvious functional relationship between the printed matter and the article exists. The Office has not established the absence of a novel, nonobvious functional relationship between the printed matter and the article exists. Accordingly, the rejection must be withdrawn.

Moreover, the Office cannot establish the absence of a novel, nonobvious functional relationship between the printed matter and the article at issue.

While the burden is on the Office establish the absence of a novel, nonobvious functional relationship between the printed matter and the article at issue, applicant will herby demonstrate a novel, nonobvious functional relationship between the printed matter and the article at issue.

The first step in determining a novel, nonobvious functional relationship, is to demonstrate a functional relationship. The second step is determining a novel, nonobvious relationship.

V(a) - Functional Relationship

As the specification indicates, a wetness indicator can be arranged at any location on an absorbent article, for example, along the side of the absorption body or on the underside thereof. Accordingly, a person, such as a nurse, can have significant difficulty locating the wetness indicator to determine if the absorption body is wet and in need of changing. For example, if the wetness indicator is an "appearing" type, such that the indicator only becomes visible when exposed to urine, a nurse will have no idea where to look for a wetness indicator that has not yet "appeared."

Thus, a colored strip<sup>1</sup> (a color that is different than the color of the remainder of the backsheet) facilitates identification of the location of the wetness indicator on or adjacent to the strip.

Clearly, the strip has a function. The function is facilitating identification.

V(b) - Novel, Nonobvious Relationship

Each of claims 1 and 2 relate to the aspect that the color of the strip is indicia that provide an indication of a **size** or **absorption capacity** of the article. The claims recite that the must provide an indication of a size or absorption capacity.

Cammarota does not disclose or suggest this. There is simply no disclosure or suggestion in Cammarota to provide a color that provides an indication of size or absorbent capacity.

The graphics in Cammarota do not provide any indicia at all. The graphics are simply present to make the article more appealing to a child undergoing toilet training. See, *for example, column 1, line 9 to column 2, line 6*. Claims 1 and 2 recite that the color of the strip (not simply the presence of a strip) is an indicia. The graphics of Cammarota do not have a specific color that indicates anything, let alone the size or absorption capacity of the article. Accordingly, Cammarota does not teach or suggest that the color of the strip is indicia that provide an indication of a size or absorption capacity of the article.

Further, each of claims 1 and 2 relate to a strip and a wetness indicator. Additionally, each of claims 1 and 2 relate to the aspect that identification of the location of the wetness indicator on or adjacent to the strip is facilitated by the strip having a color and wherein that color is different than the color of the remaining part of the backsheet.

In the *Response to Arguments* section of the Official Action (page 3, paragraph 5), the Office asserts that "locating the outer surface of the article facilitates identification of the

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<sup>1</sup> The term strip will be used hereinafter to refer to both "strip" and to "strip part."

wetness indicator." Claims 1 and 2 now recite that the location of the wetness indicator(s) on or adjacent to the strip is facilitated by the strip. Clearly, the mere identification of the outer surface (as opposed to the inner surface of a disposable article) is distinguishable from the claimed invention, which facilitates actual location of the wetness on or adjacent to the strip.

The Office asserts that the alleged strip of Cammarota is the entire width (and length) of the absorbent body. And, the Office asserts that such a strip will facilitate the identification of the location of the wetness indicator. Applicants respectfully disagree. The Office asserts that "The wetness indicator 66 [of Cammarota] is disposed on the strip part 30, and facilitated by the strip part 30 having a different color than the remaining part 34 of the backsheet." Reference number 30 actually refers to the outer surface of the training pant 20. However, applicant understands the Official Action to be referring to the shaded portion below as the claimed "strip:"

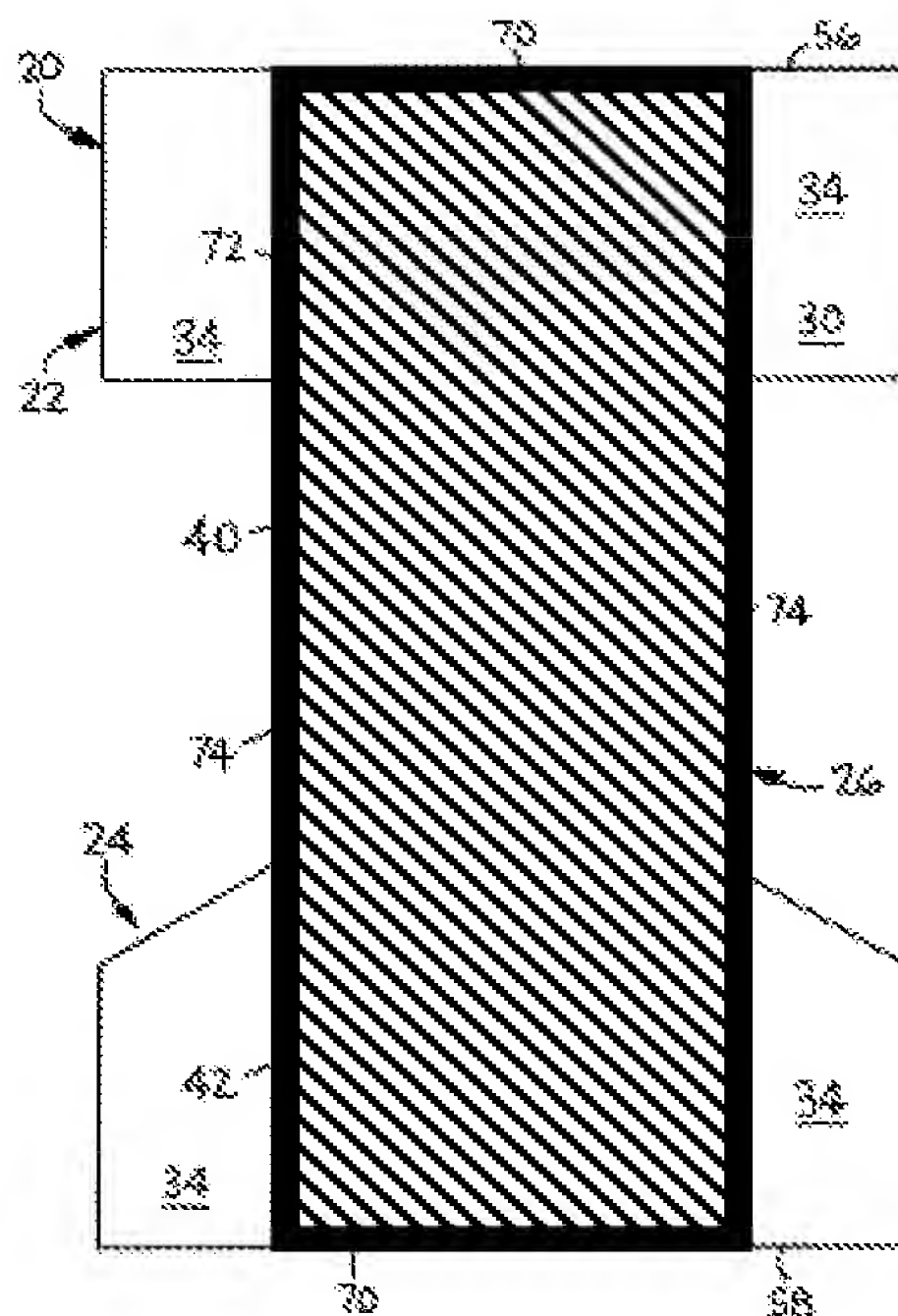


FIG. 2

The asserted strip of Cammarota cannot reasonably correspond to the presently claimed strip. The claimed strip facilitates finding the location of the wetness indicator. The asserted strip of Cammarota does not facilitate finding the location of the wetness indicator. The asserted strip of Cammarota is essentially the entire absorbent product, and is the entire area of the absorbent body.

Furthermore, to further distinguish the presently claimed invention from Cammarota, claims 1 and 2 have been amended to clarify that the width of the strip is between 1 and 6 cm. By having a relatively narrow strip, a user's attention is more easily focused on the

portion of the article where the wetness indicator may be found. Accordingly, the strip of claim 1 is much easier for a user to work with.

Moreover, it is unreasonable to suggest that one skilled in the art would think that the entire area of the absorbent body facilitates the location of a wetness indicator. Quite simply, the asserted strip of Cammarota does nothing to facilitate the location of the wetness indicators.

Applicants respectfully assert that the Office is taking an overly broad view of the claims. The Office is limited to interpreting the claims as broadly as their terms **reasonably** allow. *In re American Academy of Science Tech Center*, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004). Moreover, the Office is reminded that the claims do not stand alone but, rather, are part of a fully integrated written instrument consisting principally of a specification that concludes with the claims and, thus, **must be read in view of the specification**, of which they are part. *Philips v. AWH Corp.*, 75 USPQ2d 1321, 1327 (Fed. Cir. 2005).

How does the above diagonally-shaded area help pinpoint the location of the wetness indicator? A nurse (or caregiver) will have to search far and wide for the possible location of the wetness indicator, including possibly rolling a patient over and moving from side to side of a bed. The diagonally-shaded area simply provides no feedback as to the location of the wetness indicator.

The Office is requested to review the reasonableness of her assertion that the above diagonal area facilitates the identification of the location of the wetness indicator. Clearly, the above strip leaves the user guessing and provides no feedback as to the location of the wetness indicator.

The Office is reminded that a wetness indicator can be arranged at any location on an absorbent article, for example, along the side of the absorption body or on the underside thereof. Accordingly, a person, such as a nurse, can have significant difficulty locating the wetness indicator to determine if the absorbent article is wet and in need of changing. For example, if the wetness indicator is an "appearing" type, such that the indicator only becomes visible when exposed to urine, a nurse will have no idea where to look for a wetness indicator that has not yet "appeared." Yet, the claimed combination of the present invention overcomes this problem. The presently claimed invention explicitly provides that the location of the wetness indicator on or adjacent to the strip is facilitated by the strip part.

The presently claimed invention facilitates finding the location of the wetness indicator on or adjacent to the strip. It is **unreasonable** to suggest that the asserted strip of Cammarota facilitates finding the location of the wetness indicator. The asserted strip of Cammarota is essentially the entire absorbent product, and the entire area of the absorbent body. It is **unreasonable** to suggest that one skilled in the art would think that the entire

area of the absorbent body facilitates the location of a wetness indicator on or adjacent to the strip.

Accordingly, Cammarota does not teach or suggest the presently claimed combination which includes a strip, such that the location of the wetness indicator is facilitated by the strip.

Accordingly, claims 1, 2, 5-11 and 19-25 should now be in condition for allowance.

**§ 103(a) - Cammarota**

Claims 44 and 45 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Cammarota (USPN 6,307,119) in view of Miller (USPN 5,839,585).

Each of claims 44 and 45 recite an assortment of products comprising a plurality of absorbent articles of **at least two different** sizes or absorption capacities of the articles wherein each absorbent article comprises, inter alia, a strip part wherein different colors of the strip are an indicia that provides an indication of the difference in the size or absorption capacity of the article.

First, there is no teaching of indicia that provides an indication of size or absorption capacity. This is discussed *supra*. Cammarota is devoid of this disclosure or suggestion, and this deficiency is not remedied by Miller.

Second, the Office is asserting that two different sizes of the Cammarota diaper can be packaged together (as allegedly taught by Miller). However, packing two different sizes of the Cammarota diaper does not result in the presently claimed invention. That is, the coloring of the alleged indication in the Cammarota diaper will be the same throughout the "assortment of products." There is no indication of the difference between the **at least two different** sizes or absorption capacities of the articles.

Accordingly, claims 44 and 45 are patentable over the cited art. Entry and allowance of the claims is respectfully requested.



**Conclusion**

For at least the reasons stated above, the Examiner is respectfully requested to reconsider and withdraw the outstanding rejections and to allow the present application.

In the event that there are any questions concerning this amendment, or the application in general, the Examiner is respectfully urged to telephone the undersigned attorney so that prosecution of the application may be expedited.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: 4 March 2009

By:

A handwritten signature in black ink, appearing to read "T.D. Boone". The signature is written in a cursive, stylized font.

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